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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/579,395	12/27/1995	WILLIAM H. SWAIN		4200

7590 04/09/2004

WILLIAM H SWAIN
4662 GLEASON AVE
SARASOTA, FL 34242

EXAMINER

KARLSEN, ERNEST F

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/579,395	Applicant(s) SWAIN, WILLIAM H.	
	Examiner Ernest F. Karlsen	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The reply filed on December 1, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant's election resulted in no claims being elected. The statement at page 4, lines 12 and 13, of the Restriction/Election Requirement of November 18, 2003, which reads "With the election of any one of the above inventions further election of species is required as follows:" should be interpreted as "With the election of any one of the above inventions further election of species, as set forth only in claims found in the invention elected, is required as follows:". In other words no claim not in the elected invention can be included in the elected species. Likewise, the statement at page 6, lines 1 and 2, of the Restriction/Election Requirement of November 18, 2003, which reads "If the "Combiner" species is elected further election of subspecies is required as follows:" should be interpreted as "If the "Combiner" species is elected further election of subspecies, as set forth only in claims found in the species elected, is required as follows:". In other words no claim not in the elected species can be included in the elected subspecies. Also, the statement at page 7, lines 7 and 8, of the Restriction/Election Requirement of November 18, 2003, which reads "If the "Better-SNR" species is elected further election of subspecies is required as follows:" should be interpreted as "If the "Better-SNR" species is elected further election of subspecies, as set forth only in the claims found in the species elected, is required as follows:". In other words no claim not in the elected species can be included in the elected subspecies.

Applicant is herein given the opportunity to make a new election in accord with the Restriction/Election Requirement of November 18, 2003 and clarified above. If

Applicant wishes to continue to elect Invention I, the "Combiner" species and the subspecies of Figure 11 he may do so. Invention I includes claims 32-38, 43, 48-54, 59, 64 and 66. The Examiner considers the claims of Invention I directed to the "Combiner" species to be claims 32-38, 48-54, 64 and 66. The Examiner considers the claims of Invention I and the "Combiner" species directed to the species of Figure 11 to be claims 32, 33, 48, 49, 64 and 66.

If Applicant agrees with the above and reaffirms his previous election, claims 32, 33, 48, 49, 64 and 66 will be examined and claims 34-47, 50-63 and 65 will be withdrawn. Applicant is free to elect as he sees fit and designate claims as he considers appropriate, but is advised, that his election to be accepted, must be within the rules.

Applicant has contested the Restriction/Election Requirement on the basis that the basic concept which includes the primary teaching is contained in one form or another in each and every claim. This is not found persuasive because Applicant has not shown that the inventions, species and subspecies are not patentably distinct. Applicant says in arguments that the claims are not patentably distinct and then argues that all claims are different and should be examined individually. The Examiner has withdrawn several previous restriction requirements in response to Applicant's arguments of "sameness" only to have Applicant shift his stand to the claims being different. The Examiner stands with Applicant's previous arguments that the claims are different.

Applicant's most recent statement that "no one claim is patentably distinct from another" appears in the fifth line from the bottom of page 3 of his Petition of December 1, 2003. Applicant presents further argument that his claims are not patentably distinct because they all include some form of the basic concept, i.e., the "Discovery" or the "Essential Characteristic" and so are not patentably distinct. This is akin to arguing that any claim that includes the basic concept of Ohm's Law is not patentably distinct from any other claim that includes the basic concept of Ohm's Law. By such logic a claim to details of a light bulb would not be patentably distinct from a claim to details of a relaxation oscillator. Both rely on Ohm's Law.

Since Applicant has a web page for his business, it is assumed that he has access to the internet. A current copy of Chapter 8 of the M.P.E.P. can be found at http://www.uspto.gov/web/offices/pac/mpep/mpep_e8_0800_508.pdf. Laws are enacted by Congress and interpreted by Courts and Officials of Agencies, in the present case, the Courts and the Commissioner of Patents. The phrase "independent and distinct" has been interpreted as "independent or distinct" as set forth in M.P.E.P. Chapter 8, Section 803. Page 800-3 of Chapter 8 contains Section 802.01 relating to the meaning of "independent and/or distinct". Under the heading "Independent" in the second column of page 800-3 it is stated that "species under a genus which species are not usable together as disclosed" are independent. Applicant has argued in his Appeal Brief filed May 24, 2003, at pages 3 and 9 that he has two species, the "Better-SNR" species and the "Combiner" species. The species are independent. The subspecies as set forth on page 6 of the Restriction/Election Requirement of November 18, 2003 are

clearly independent as set forth in the second column of page 800-3 because each of the species is represented by a different figure or a verbal description which would require a different figure if presented in a figure. Species and subspecies are treated in the same way. Under the heading "Distinct" in the second column of page 800-3 process of making, apparatus, method of use of apparatus and some other categories are indicated to be "distinct" if subjects as disclosed are capable of separate manufacture, use or sale as claimed and are patentable over each other.

The Examiner has made several restrictions stating that inventions represented by groups of claims are distinct and in effect saying that they are patentable over each other. Applicant has responded saying that the inventions are not distinct and therefore not patentable over each other. The Examiner has responded to Applicant's admission of "not distinct" and therefor not patentable over each other by withdrawing all restrictions and acting on one claim since Applicant has stated that the inventions are not patentable over each other. Applicant then responds stating that the inventions are different and all claims should be acted on independently.

The definition of the word "distinct" seems to be at the root of the controversy. Applicant should look to the cited part of Section 802.01 of the M.P.E.P. for a definition of "distinct".

Challenge of a Restriction/Election Requirement stating that the inventions are not "distinct" is not the way to go because it is equivalent to saying that the fall of any one claim means that all claims fall. Admission on the record that inventions are not patentably distinct is something that knowledgeable patent attorneys never do because

of the position it puts them in before the Patent Office or before a court when the fall of any one claim results in the fall of all claims.

The only reasonable way, in the Examiner's opinion, to attack the propriety of a restriction requirement is to argue that the Examiner made an error in applying the rules governing restriction.

Applicant was advised of the desirability of obtaining the services of a registered patent attorney or agent in an Office Action mailed January 16, 1998.

See 37 CFR 1.111. Since the above-mentioned reply filed December 1, 2003 appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication should be directed to Ernest F. Karlsen at telephone number 571-272-1961.

Ernest F. Karlsen
February 25, 2004


**ERNEST KARLSEN
PRIMARY EXAMINER**



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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0204

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

See attachments:

Sheets 2-6
PTOL-413

Ernest P. Karlson

ERNEST KARLSEN
PRIMARY EXAMINER